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Reply Brief Under 37 C.F.R. § 41.41

Attorney Docket No.: 019213-0311368

Application Serial No.: 09/877,926

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re PATENT APPLICATION of:

PAUL H. ROBB

Application No.: 09/877,926

Group No.: 3624

Filed: June 8, 2001

Examiner: Campen, Kelly Scaggs

Title: METHOD AND SYSTEM FOR ENABLING COLLABORATION BETWEEN ADVISORS AND CLIENTS

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

- REPLY BRIEF UNDER 37 C.F.R. § 41.41 -

Sir:

The Appellants hereby submit this Reply Brief in response to the Examiner's Answer of May 7, 2007.

I. REPLY ARGUMENT

The Examiner's rejections should be reversed because the applied references simply do not teach or suggest each and every claim limitation and because all the claims are definite.

A. Claims 1-59 are Not Obvious in View of Zucknovich, Alone or in Combination with Other Cited References

The instant invention is drawn towards a method and system for enabling interaction between a financial services team (e.g. a client and one or more service financial providers for that client). The interaction is enabled through a common forum containing client data (e.g.

data pertaining to an individual but which may be needed or desired by one or more other members of the team), where the client data can be accessed by team members subject to predefined authorizations. The common forum enables interaction among the client and financial service providers and among the financial service providers themselves. For example, claim 1 recites the step of "enabling the financial services client to interact with one or more financial service provider participants through the common electronic forum... [and] enables interaction among the one or more participants through the common forum." Additionally, the claim recites that through the common forum "client data is accessible within the scope of access authorized to each participant."

Zucknovich fails to teach or suggest such a method or system. Zucknovich is directed towards a fundamentally different system. For example, Zucknovich discloses a system that enables a contributor, such as an investment analyst, to submit a report to a central site. Zucknovich at col. 6, lines 18-39. The contributor can authorize access to the entire report to a select group of investors. *Id.* at col. 11, lines 40-45. A repository server can then notify an authorized investor that the report has been received by the central site. *Id.* at col. 7, lines 25-31. The authorized investor can then select the report in order to view or print the report. *Id.* An investor can also perform queries on the central site such as queries to identify all reports that the investor has been authorized to view or queries to identify reports pertinent to a particular subject. *Id.* at col. 10, lines 50-65.

The system of Zucknovich is not a common forum that enables communication between the contributor and the investor. Nor does it provide communication between the investors (whom the Examiner is apparently relying on as "participants"). Additionally, while the Examiner has not demonstrated how the research report submitted by a contributor in Zucknovich constitutes "client data", as claimed, even if it satisfies this recitation, Zucknovich fails to teach or suggest that the research report is subject to a "scope of access." In Zucknovich, the investor either has access to the report or does not.

Moreover, it is clear the Examiner has relied on the wrong legal standard in interpreting "interact" and "exchange." The Examiner states the obviousness rejection in view of

Zucknovich is based on giving these terms their "broadest possible meaning." Answer at 9. Of course, it is beyond argument, that the proper test is the "broadest reasonable interpretation consistent with the specification." MPEP 2111, citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005).

With respect to the Examiner's assertion at page 10 of the Answer that Zucknovich in view of Moran is "admitted prior art", this is not the case. Appellants have made no such admission. Each of these rejections fails to establish a prima facie case of unpatentability at least due to the deficiencies of Zucknovich. While other arguments may exist over the combination, since the Examiner has failed to establish a prima facie case of obviousness, the other reasons need not be addressed at this time.

At page 10 of the Answer, the Examiner misstates the argument regarding non-analogous art. Appellants argue that neither Zucknovich nor Day is analogous art. In any event, the Examiner has not established that at least Zucknovich is in the Appellants' field of endeavor or directed to the same problems. Zucknovich relates to a subscription-based research report system. This does not relate to a collaborative forum that enables a team of financial service providers to interact with a common client and common client data. Moreover, the Examiner fails to set forth a proper legal or factual basis for alleging that the prior art addresses the same problems as the instant invention. The Examiner asserts (without support) that Zucknovich is capable of performing the function of the instant application. There is no legal basis for alleging that this is sufficient to establish that Zucknovich is "reasonably pertinent" to the same problems as the invention.

Thus, Zucknovich fails to teach or suggest at least the elements recited above and is non-analogous art. Because Zucknovich fails to teach or suggest each and every limitation of the claimed invention and is non-analogous art, as a matter of law Zucknovich cannot render the claimed invention obvious. Each of independent claims 15, 28, 42, and 57 contain similar features as claim 1 and thus Zucknovich cannot render obvious these claims for the same reasons as with respect to claim 1. With respect to the rejections based on Zucknovich in view of Moran, Carter, and Day, respectively, each of these secondary references fails to cure the

deficiencies of Zucknovich noted above. Accordingly, Appellants respectfully request the reversal of all rejections based on Zucknovich, alone or in combination with other cited references.

B. The Examiner's "Response to Argument" Mischaracterizes Zucknovich

In response to Appellants' arguments, the Examiner states that Zucknovich discloses "interaction in the form of discussing the research reports." Answer at 9. The Examiner has not established this as a sufficient teaching or suggestion of the "interaction" required by the claimed invention. Moreover, Appellants can find **no support** in Zucknovich of any disclosure of a common forum for contributors or investors "discussing" research reports. Certainly, the Examiner provides no citation.

The Examiner also states that "one cannot show nonobviousness by attacking references individually where the rejections are based on **combination of references**." Answer at 9 (emphasis added). The rejection of claims 1-5, 7-19, 22-32, 34-46, 49-54, and 57-58 under 35 U.S.C. § 103 based solely on Zucknovich is **not** "based on combination of references" and thus it is completely proper to attack the deficiencies of Zucknovich individually. To the extent these deficiencies apply to the rejection of other claims where Zucknovich is used in combination with other references, there too, it is proper to attack the rejections via attacking Zucknovich.

C. The Claims are Clear and Definite

The Examiner rejects claims 1-59 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Answer at 4. The Examiner states that the following plain English terms are indefinite: "collaborate", "enabling", "to interact", "forum", "events", "actions", "client", "participants", and "library of resources." *Id.* Appellants submit that none of these rejections have a proper legal basis. Each of these terms is well known in the art and is described in the specification. Therefore, one of ordinary skill in the art would have no trouble discerning their meaning, as used in the claims, in light of the specification.

The Examiner also states that the term "system" is vague and indefinite "since a system may be one of several different statutory classes of invention." Answer at 4. The rejection of claims 28-54 for the recital of "system" appears under the heading of "Claim Rejections – 35 USC § 112" and not under a rejection based on 35 U.S.C. § 101. Since, there is no rejection based on 35 U.S.C. § 101, it is unclear what the relevance is of which of the "statutory classes of invention" the claim falls within with regards to claims 28-54. If claims 28-54 do not fall within any one of the four statutory classes of invention under 35 U.S.C. § 101, the Examiner should have rejected the claims for failing to satisfy that section. But clearly systems are commonly claimed and constitute statutory subject matter. In response to Appellant's arguments, the Examiner states "there is a requirement for an indication on the record as to what statutory class of invention the 'system' claims belong to (see MPEP 2106.IV.B)." Answer at 9. Section 2106.IV.B entitled "Determine Whether the Claimed Invention Falls Within An Enumerated Statutory Category" is a subsection of 2106.IV entitled "Determine Whether the Claimed Invention Complies with 35 U.S.C. 101" which is a subset of 2106 entitled "Patent Subject Matter Eligibility." Thus, Section 2106.IV.B of the MPEP relates to 35 U.S.C. § 101, not to 35 U.S.C. § 112. Furthermore, compliance with Section 2106.IV.B does *not* require "an Applicant" to provide "an indication on the record as to what statutory class of invention the 'system' claims belong to." Appellants have reproduced select passages of 2106.IV.B below (emphasis added):

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within *at least one* of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter).

The question of whether a claim encompasses statutory subject matter *should not* focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.

As such, there is clearly no legal or factual basis for the Examiner's rejection of claims 28-54 for the use of "system" in the claims. Accordingly, Appellants respectfully request the reversal of all rejections based on 35 U.S.C. § 112.

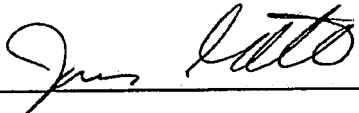
II. CONCLUSION

In conclusion, Appellants respectfully submit that, based on the reasons advanced above and in the Appeal Brief, the claims under appeal are all patentable. Accordingly, Appellants respectfully request reversal of all grounds of rejection.

Date: _____

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